



Patent
Attorney's Docket No. 032326-083

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)

Philippe PATRICE)

Application No.: 09/623,796 ✓)

Filed: September 8, 2000)

For: METHOD FOR MAKING)
CONTACTLESS CARDS)

Group Art Unit: 3729

Examiner: M. Trinh

Confirmation No.: 6700

#7 / Reo. w/d
final
- argument

RECEIVED
JUL 08 2003
TECHNOLOGY CENTER R3700

**REQUEST FOR WITHDRAWAL OF THE
FINALITY OF THE OFFICE ACTION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the second Office Action dated June 26, 2003, the rejections of claims 1-8 on the basis of the Moskowitz et al patent were maintained. In addition, a new ground of rejection was set forth, in which these claims were rejected as being anticipated or obvious in view of the Kohama et al patent. The Office Action was made final, and states that Applicant's amendment necessitated the new ground of rejection presented therein. It is respectfully submitted, however, that the finality of the Office Action is premature in view of the new grounds of rejection, and its withdrawal is therefore respectfully requested.

The first Office Action dated January 31, 2003, contained a rejection of claims 1-8 under the second paragraph of 35 U.S.C. §112, in addition to the above-noted rejections based upon the Moskowitz et al patent. In the response filed April 30, 2003, Applicant traversed the §112 rejection, but also amended the claims to remove the specific points of objection set forth in the §112 rejection. These amendments were presented *solely* for the

purpose of removing the §112 rejection. Applicant specifically stated that "No change in claim scope is intended." In traversing the rejection based upon the Moskowitz et al patent, Applicant referred to features of the invention recited in the original claims. The amendments were not necessary, or relied upon, to distinguish the invention from the Moskowitz et al patent.

The Kohama et al patent was cited for the first time in the most recent Office Action, and forms the basis for new grounds of rejection. MPEP §706.07(a) states:

second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection *neither necessitated by applicant's amendment of the claims* nor based on information submitted in an information disclosure statement. . ." (emphasis added)

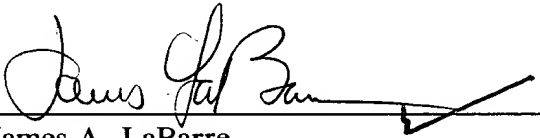
There has been no showing that the amendments to claims 1-8, to address the rejection under 35 U.S.C. §112, "necessitated" the new grounds of rejection based upon the Kohama et al patent. Rather, the reference is apparently being relied upon to supplement deficiencies in the rejection based upon the Moskowitz et al patent. The amendments did not introduce any new substantive issues that were not before the examiner at the time of the first Office Action. Hence, if the claims are properly rejectable on the basis of the Kohama et al patent, such a rejection should have been set forth in the first Office Action. Failure to do so precludes the current Office Action from being made final.

Accordingly, Applicant respectfully requests that the finality of the Office Action dated June 26, 2003 be withdrawn, as premature.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 7, 2003

By: 
James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620